



UNITED STATES PATENT AND TRADEMARK OFFICE

HD

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------------|
| 09/976,836 | 10/12/2001 | Charles Eric Hunter | 05001.1010 | 2310 |
| 23377 7590 05/18/2007 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891 | | | EXAMINER FADOK, MARK A | |
| | | | ART UNIT 3625 | PAPER NUMBER |
| | | | MAIL DATE 05/18/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/976,836

Applicant(s)

HUNTER ET AL.

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-49 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-49 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicant's response to office action mailed 9/22/2006, which was received 2/23/2007. Acknowledgement is made to the amendment to claims 31,36,39,42,43,45-47. the cancellation of claim 50 and the addition of claim 51. Applicant's amendment and remarks have been carefully considered and found to be convincing in overcoming the previous rejection, however, after further searching the following rejection necessitated by amendment follows:

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention, which is also disclosed, in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No.'s 09/645,086, 09/567,716, 09/564,386, 09/465,729, fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In this case at least "order/assigning security clearance security clearance for a particular venue from a plurality of venues" is only found in the instant application therefore the priority given to the instant application is that of October 12, 2001, which is the filing date of the instant invention.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3625

The term "minimizes" in claim 49 is a relative term, which renders the claim indefinite. The term "minimizes" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 31-35,39-44 and 47-49 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Stanard (US PG PUB 20030024988).

In regards to claim 42, Stanard discloses providing information to a venue and a customer to verify identity (para 11) and does make reference to the security of the system, but does not specifically mention that the product being requested is a security clearance. Since the limitation of security clearance does not impart any functionality this limitation is considered to be non-functional descriptive material (see MPEP 2106(b)) and is therefore not considered to provide patentable distinction. The examiner contends that the method and system would work equally well with the purchase of a ticket that is used to verify the customer's identity and thus provides the benefit of increased security through the method of Stanard. Further, applicant has conceded that

Art Unit: 3625

a security clearance is a product in applicant's response received 2/23/2007 (see page 7 first paragraph).

said interface operable to receive requests for products, services and security clearances provided by a plurality of merchants and venues (para 0011) ;

assigning a security clearance for a particular venue chosen from a plurality of venues by an individual and transmitting said security clearance to said device remote from said plurality of venues (FIG 4),

wherein the security clearance is based on at least a verification of the individual's identity (para 0011); and

routing information related to the verification of the individual's identity to a check-point (FIG 4),

wherein the verification of the individual's identity occurs before the arrival of the individual at the check-point (para 0022), and

In regards to the whereby clause a "whereby" clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1018 (CAFC 1993). In this case, claim 12 was directed to a process for encapsulating a semiconductor device by injecting an insulating fluid into a mold holding the device "whereby the fluid will not directly engage the device and electrical connection means at high velocity, and the conductors will be secured against appreciable displacement by the fluid". The court held that this clause only expressed the necessary results of what is recited in the rest of the claim based on how the device was held by the mold.

Art Unit: 3625

Another example of a “whereby” clause that did not add to the substance of the claim is found in *Minton v. National Association of Securities Dealers Inc.*, 67 USPQ2d 1614 (CAFC 2003). In the method of claim 1, offers to trade a security are transmitted over a network to an individual's computer, where the offers are ranked and displayed. The individual replies to an offer, and the system responds by “executing a trade of the security based on information contained in the offer for consideration specified in the reply to the offer, whereby the security is traded efficiently” between the offerer and the individual. The court stated that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited”. In the eyes of the court, “the term ‘efficiently’ on its face does not inform the mechanics of how the trade is executed, and nothing in the specification or prosecution history suggests otherwise. Rather the term ‘efficiently’ is a laudatory one characterizing the result of the execution step”. It is clear that benefit of expediting entry does not impart and further limitation to the previous steps and is therefore is given little patentable weight.

In regards to claim 43, Stanard teaches wherein said transmitting said security clearance to a device remote from a venue comprises:
said transmitting said security clearance to a the telephone (para 0014).

In regards to claim 44, Stanard teaches wherein the verification is confirmed at the check-point by a code obtained by the individual via the interface (para 0011).

In regards to claim 47, Stanard teaches wherein the verification of the individual's identity includes routing a request to said check-point to further verify the individual's identity in addition to the verification of the individual's identity routed to the check-point (para 0035).

In regards to claim 48, Stanard teaches wherein the check-point provides access to a public venue (para 0011).

In regards to claim 49, Stanard teaches wherein the verification minimizes at least one security measure performed at the check-point upon the individual's arrival (para 0035)

claims 31-35 and 39-41 are considered parallel claims to the claims above and are rejected for the same rationale.

In regards to claim 51, Stanard discloses a method for expediting security by providing for the ordering of a product in the form of a security clearance comprising:
receiving from a customer a multi-digit code, wherein said multi-digit code is related to a verification of the customer's identity (para 0011-0013);

transmitting said multi-digit code to an identity verification system, wherein said multi-digit code was previously given to said customer by said identity verification system after said customer had ordered security clearance for a particular venue from a plurality of venues (FIG 4); and
receiving a confirmation of the customer's identity from said identity verification system, wherein said confirmation is based at least in part on the confirmation of the multi-digit code (para 0035).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36,37,38 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanard in view of Mahnken et al (PgPub 20040030640).

In regards to claims 36,37,38, 46, Stanard teaches collecting data on individuals but does not specifically mention that a security risk is calculated on the individual. Mahnken teaches performing real-time background checks that include information gathered from third party sources (claims 5 and 6). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Stanard a scoring module for determining risk as is taught by Mahnken, because this

Art Unit: 3625

would add additional security and assure that individuals that were considered a risk would not be permitted to buy a ticket (Mahnken, para 0056).

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanard in view of Official Notice.

Stanard discloses the claimed invention except that only one check-point is shown. It would have been obvious to one having ordinary skill in the art at the time of the invention to include multiple check-points, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. In re Jepikse, 86 USPQ 70. Stanard would be motivated to include multiple check points, because this would allow a user to enter from any gate of a venue thus reducing frustration on the part of the user by having to find a single entry point.

Response to Arguments

Applicant argues that that priority should be granted to the prior filed application. The examiner disagrees, applicant has not indicated where in the previous references all the claimed features may be found. Please note that the examiner only cited one of the features, but in order to receive priority applicant must identify where in each of the references the features may be found and if from different applications how the features will be combined. Applicant has not provided sufficient arguments to identify all the

Art Unit: 3625

features were present in the previous application, therefore applicant has not provided a prima facie case for granting priority to the previous applications.

Applicant argues that Cockerham's provisional application does not provide support for the rejection of independent claims 31 and 42. The examiner disagrees and finds that Cockerham's provisional has sufficient disclosure to reject the prior claims treated in the previous office action.

Applicant's arguments with respect to claims 31-49 and 51 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3625

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**.

The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey A. Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300

[Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3625

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a long horizontal flourish extending to the right.

Mark Fadok

Primary Examiner